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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/527,383

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Stephen D. Newman

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EXAMINER

REYNOLDS, STEVEN ALAN

ART UNIT

PAPER NUMBER

3728

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/527,383	Applicant(s) NEWMAN ET AL.	
	Examiner Steven Reynolds	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-98 is/are pending in the application.
- 4a) Of the above claim(s) 1-69, 71, 73, 74, 87 and 89-98 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 70, 72, 75-86, 88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/17/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group 1, Species 7 in the reply filed on 7/2/2008 is acknowledged. The traversal is on the ground(s) that the entire application can be examined without serious burden. This is not found persuasive because there are many diverging species which require separate search for each, as well as the extensive number of claims in the application.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-69, 71, 73, 74, 87 and 89-98 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/2/2008.

Claims 25-39 are withdrawn from consideration as they are directed to a non-elected species, Species 5. These claims are directed to a storage system comprising a **plural** number of packages containing a contact lens to be used in the left eye and a **plural** number of packages containing a contact lens to be used in the right eye, which is not part of elected Species 7.

Claims 71, 73, 74, 87, 89 and 90 are withdrawn from consideration as they are directed to a non-elected species, Species 13. These claims are directed to a holder for contact lens comprising a base with a hinged lid, receptacles that slide out, and receptacles in the lid and base, which is not part of elected Species 7.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. **It is important that the abstract not exceed 150 words in length** since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 72, 75-77, 82 and 84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 77 recites the limitation "the bottom and top of the case" in line 2. There is insufficient antecedent basis for this limitation in the claim. For purpose of examination, Examiner assumes that claim 76 should read "the contact lens **case** has a top and bottom".

Regarding claim 82, it is not clear why the holder would be replaced after the time has elapsed. For purposes of examination, Examiner assumes "the contact lens holder" should be "the contact lens case".

Further regarding claims 72, 75-77, 82, 84 and 85, it is not clear whether applicant is claiming the combination of the holder and the contact lens cases because the contact lens cases are not positively claimed in independent claim 70, they are merely presented as intended use of the holder. For purposes of examination, Examiner assumes applicant is claiming a reusable holder capable of being used to hold contact lens cases. The prior art reusable holders must only be capable of holding contact lens cases with such features as presented in dependent claims 72, 75-77, 82, 84 and 85. The specific features of these dependent claims merely further limit the intended use of the reusable holder.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 70, 72, 75-77, 79-86 and 88 are rejected under 35 U.S.C. 102(b) as being anticipated by Cuppari (US 4,909,382). Cuppari discloses a reusable holder (10) capable of holding contact lens cases comprising: a lid (18); a base (12); one or more receptacles (recess in the base) capable of holding a contact lens case; and a time keeping device (44), wherein the time keeping device comprises an indicator (45) for

each one or more receptacles that indicates a period of time that has elapsed since the contact lens case currently in the receptacle was placed therein.

Regarding the intended use of the claimed invention “for contact lenses”, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. If the prior art structure is capable of performing the intended use, then it meets the claim. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 72, 75-77, 85, the holder of Cuppari is fully capable of holding contact lens cases with such features as presented in these claims. The specific features of these dependent claims merely further limit the intended use of the holder.

Regarding claims 79-84, 86 and 88, Cuppari discloses the indicator shows the period of time that has elapsed by displaying a number, which can be ran until a number of days have elapsed; the indicator shows the period of time that has elapsed by changing from one color to another (since the numbers on the display have a color, as the numbers change, the color on the display is changing); contact lens cases can be replaced after the period of time has elapsed; the holder is made of plastic; the time is reset when a new contact lens case is inserted; a battery (See column 2, line 60); and the holder has receptacles (two recesses to hold contact lens cases) in the base.

8. Claims 70, 72, 75-77, 79-82, 84-86 and 88 are rejected under 35 U.S.C. 102(a) as being anticipated by Scala (US 6,382,409). Scala discloses a reusable holder (12)

capable of holding contact lens cases comprising: a lid (20); a base (16); one or more receptacles (recess in cup 14) capable of holding a contact lens case; and a time keeping device (28), wherein the time keeping device comprises an indicator (32) for each one or more receptacles that is capable of indicating a period of time that has elapsed since the contact lens case currently in the receptacle was placed therein.

Regarding the intended use of the claimed invention “for contact lenses”, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. If the prior art structure is capable of performing the intended use, then it meets the claim. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 72, 75-77, 85, the holder of Scala is fully capable of holding contact lens cases with such features as presented in these claims. The specific features of these dependent claims merely further limit the intended use of the holder.

Regarding claims 79-82, 84, 86 and 88, Scala discloses the indicator shows the period of time that has elapsed by displaying a number, the indicator shows the number of days elapsed; the indicator shows the period of time that has elapsed by changing from one color to another (since the numbers on the display have a color, as the numbers change, the color on the display is changing); contact lens cases can be replaced after the period of time has elapsed; the time is reset when a new contact lens case is inserted; a battery (inherently has a battery to display the LEDs); and the holder has receptacles (two recesses in the cups) in the base.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 78 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cuppari (US 4,909,382) in view of Artis (US 5,699,900). As described above, Cuppari discloses the claimed invention except is silent about the specifics of the display. However, Artis teaches a contact lens holder comprising a time keeping device (44) with a LCD display (See column 3, lines 34-35) for the purpose of displaying a count value. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the display of Cuppari to be an LCD display as taught by Artis in order to provide a clear display.

12. Claim 78 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scala (US 6,382,409) in view of Artis (US 5,699,900). As described above, Scala discloses

the claimed invention except that the display is LED instead of LCD. Artis shows evidence that LED/LCD were art-recognized equivalent structures for displaying numbers. Therefore, because these two displays were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute LED for LCD. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

13. Claim 83 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scala (US 6,382,409). As described above, Scala discloses the claimed invention except is silent about the specific material the holder is made from. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the holder from any material such as plastic in order to give it the desired strength. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Reynolds whose telephone number is (571)272-9959. The examiner can normally be reached on Monday-Friday 9:30am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. R./
Examiner, Art Unit 3728

/J. Gregory Pickett/
Primary Examiner, Art Unit 3728